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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,790	12/19/2001	Bernhardt Dilz	225/50372	4260

7590 12/17/2004  
Crowell & Moring  
PO Box 14300  
Washington, DC 20044-4300

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/914,790

Applicant(s)

DILZ ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-32 is/are allowed.
- 6) ☒ Claim(s) 14-23 and 33-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claim 14 has been amended for further examination.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 14-21, 23 and 33-35 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Gosselin et al (5,885,677).

Gosselin discloses in Fig. 1 and 2, a security film comprising a carrier layer (26) containing an identification medium (32), wherein the identification medium is variedly diffused (through intermittent spacing of the barrier layer) from the security film to a substrate (30, in Fig. 2); a weakened barrier layer (24) arranged between the carrier layer (26) and the substrate (30) and which, in an uninscribed state prevents diffusion (however, not fully, as disclosed in Col. 5, lines 35-43) of the identification medium from the film to the substrate; wherein the identification medium comprises at least one from the group consisting of UV-fluorescent marker substance, infrared marker substance, magnetic marker substance, and a dye (Col. 5, lines 6-10); wherein the

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identification medium consist of a substance that causes a chemical reaction in the substrate to etch a surface of the substrate (Col. 2, lines 5-8); wherein the security film is arranged on a release paper (28); and wherein the security film can be placed on a Vehicle Identification Number label, which is then placed on vehicle paint (Col. 6, lines 25-55).

In regards to **Claims 14-17**, wherein the barrier layer is weakneable by a contactless inscription process after the barrier layer has been arranged on the carrier layer; and wherein the local weakening is achieved by a local action of: electromagnetic radiation; heat; or a laser beam does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious form a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113 and 716.01). Therefore, it would be obvious to incorporate intermittent spacing of the barrier layer to allow the diffusion of the identification in preselected areas.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 22 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al in view of Pennance et al (EP-845,767).

Gosselin et al discloses a security film comprising all the elements as claimed in Claim 14, and as set forth above. However, Gosselin et al does not disclose wherein the security film has a laser-inscribable covering layer.

Pennance et al discloses a security film (10) having a laser inscribable covering layer (14).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gosselin et al's security film with a laser-inscribable covering layer as taught by Pennance et al for the purpose of imparting permanent indicia on the film for prevention of tampering.

***Allowable Subject Matter***

4. Claims 24-32 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a method of inscribing a security film that is adhesively bonded to a

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substrate; wherein the method comprises bonding a security film to a substrate, wherein the film comprises a carrier layer containing an identification medium and a barrier layer arranged between the carrier layer and the substrate; inscribing the security film by a contactless process to weaken the barrier layer and allow selective diffusion of the identification medium from the film to the substrate; wherein the diffusion properties of the identification medium are changed.

***Response to Arguments***

6. Applicant's arguments filed on April 2, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the Gosselin reference does not disclose or suggest a barrier layer in which "local variation in the diffusion is produced by local weakening of the barrier layer after the barrier layer has been arranged on the carrier layer", the examiner submits that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious form a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113 and 716.01). Therefore, it would be obvious to incorporate intermittent spacing of the barrier layer to allow the diffusion of the identification in preselected areas.

Therefore, the examiner's rejection has been maintained.

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***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (571) 272-4483. The fax number for TC 3700 is (703)-872-9306.



MTH

December 12, 2004



A. L. WELLINGTON  
SUPERVISOR      SENIOR EXAMINER  
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